



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Liqing Liu

Serial Number: 09/923,368

Filing Date: August 8, 2001

Title: Use of Aluminum in Perforating and Stimulating a Subterranean Formation and Other Engineering Applications

Examiner: Peter A. Nelson

Art Unit: 3641

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OFFICE OF PETITIONS

MS Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**BRIEF IN SUPPORT OF PETITION FOR REVIVAL OF AN APPLICATION
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

In accordance with 37 C.F.R. 1.137(b), Applicant hereby petitions for revival of the above-identified application that was unintentionally abandoned for failure to reply. In support of this Brief, Applicant submits the following:

TIMELINE OF EVENTS:

- The following is a brief synopsis of dates pertinent to this matter:
 - 08/08/2001 Original U.S. Application Serial No. 09/923,368 filed with Patent Office
 - 08/15/2001 Applicant travels from Canada to Beijing, China on business (See Liu Statement, ¶ 6)
 - 09/28/2001 Applicant returns to Canada from China (See Liu Statement, ¶ 6)
 - 07/28/2002 Applicant travels to Germany on business (See Liu Statement, ¶ 7)
 - 09/30/2002 Non-Final Rejection mailed.
 - 02/02/2003 Applicant returns to Canada from Germany (See Liu Statement, ¶ 7)

- 05/17/2003 Applicant's father suffers a stroke, leaving him half paralyzed (See Liu Statement, ¶ 9)
- 06/27/2003 Application Abandoned for Failure to Respond to Office Action
- 09/18/2005 Applicant learned Application had been abandoned (See Liu Statement, ¶ 10)

BACKGROUND:

Dr. Liqing Liu is a Chinese national who lives and works in Calgary, Canada. In early June, 2001 Dr. Liu contacted a patent attorney in Canada named Thomas Malyszko about filing a United States patent application for one of his inventions. Because English is Dr. Liu's second language, communication between Dr. Liu and Malyszko was difficult from the very beginning. In fact, it took Malyszko more than two months to get all of the information he needed from Dr. Liu to file the patent application. After collecting the relevant information from Dr. Liu, Malyszko filed the application in September of 2001.

Soon after the patent application was filed, Dr. Liu was called away to Beijing, China on business. Approximately nine months after he returned from China he was called away from Canada on business again, this time to Germany. His stay in Germany lasted almost 7 months. Unfortunately for Dr. Liu, his business trip to Germany occurred during a crucial time for his patent application. While he was in Germany, the Patent Office issued an Office Action for Dr. Liu's application. If Malyszko tried to contact Dr. Liu to tell him about the Office Action or otherwise inform him as to the status of the application, he was unable to because Dr. Liu never received any communications from Malyszko after the application was filed.

Dr. Liu's frequent travels out of the country made it extremely difficult for his patent attorney to get in touch with him. The situation was further complicated by the fact that Dr. Liu has virtually no knowledge about the process involved in obtaining a U.S. patent. Consequently, Dr. Liu had no idea about the time frames involved, the deadlines that must be met, and the steps that would be required of him in order to successfully prosecute a patent application. Dr. Liu thought he gave Malyszko everything Malyszko needed to patent his idea during their initial conversations prior to the filing of the application, and assumed he would hear from Malyszko when the process was complete.

To complicate matters even further, Dr. Liu's father had a stroke in May of 2003, which left half of his father's body paralyzed. Having such a serious illness in his family drew all of Dr. Liu's attention away from everything else that was happening in his life, including his patent application.

Dr. Liu did not hear anything from Malyszko until August, 2005, when Dr. Liu contacted him. Dr. Liu was prompted to inquire as to the status of his patent application because he had received a phone call from a party interested in purchasing a license for his idea. It was then that Dr. Liu was shocked to learn that his patent application had been abandoned. Dr. Liu immediately began the process of reviving his unintentionally abandoned patent application.

GROUND FOR REVIVAL:

In accordance with 37 C.F.R. 1.137(b), revival of the above-referenced application is proper under the circumstances. Applicant did not receive notice of the Non-Final Rejection, so as to respond in a timely manner prior to the abandonment of the Application, nor did Applicant learn of the abandoned status of his application until long after it had been abandoned. Consequently, the Application was unintentionally abandoned and should be revived under 37 C.F.R. 1.137(b).

The Manual of Patent Examining Procedure addresses the qualifications for unintentional delay as follows:

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken.

A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional" delay within the meaning of 37 CFR 1.137(b) because:

- (A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;
- (B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;
- (C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;
- (D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or
- (E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.

See MPEP § 711.03(c)(II)(C)(1) 8th ed., May 2004 (internal citations omitted).

Clearly, Dr. Liu cannot be said to have deliberately permitted his application to become abandoned as contemplated by the MPEP section cited above. Sections (A) through (E) above, which list deliberate courses of action that do not cause "unintentional delay" within the meaning of 37 C.F.R. 1.137(b), are all situations where the applicant makes an informed, thoughtful, and purposeful decision not to prosecute the patent application. Here, Dr. Liu's lack of knowledge of

U.S. patent law and prosecution practice, trouble speaking and understanding English, frequent business trips away from Canada, and dealings with his father's illness do not fall into the same category as the "deliberately chosen courses of action" not constituting "unintentional delay." Dr. Liu fully expected his patent attorney to prosecute the application to completion and thought he had done all that was necessary to effect such prosecution.

Under the circumstances, it would be inequitable for the Patent Office to discard Dr. Liu's entire Application where there is no evidence that he intended to abandon it. Dr. Liu has taken all reasonable steps to inquire into the status of the Application, and upon learning the circumstances under which the Application had become abandoned, took all reasonable measures in a timely manner to rectify the situation.

If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact David W. Carstens at 972.367.2001.

The Commissioner is hereby authorized to charge payment of any further fees associated with any of the foregoing papers submitted herewith, or to credit any overpayment thereof, to Deposit Account No. 50-0392.

Respectfully submitted,

By: 

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Date: August 17, 2006
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